

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85964292
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/85964292/large
LITERAL ELEMENT	ALLEGHENY HEALTH NETWORK
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of stylized wording "Allegheny Health Network" to the left of an array of nine diamonds forming a larger diamond shape with curved sides.
ARGUMENT(S)	
Applicant's arguments have been submitted as a pdf document as part of the Evidence File.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_101572-20151203105454214945_.HIIP-7_Arguments.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\859\642\85964292\xml19\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\859\642\85964292\xml19\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\859\642\85964292\xml19\RFR0004.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\859\642\85964292\xml19\RFR0005.JPG
ORIGINAL PDF FILE	evi_101572-20151203105454214945_.HIIP-7_2nd_Declaration.pdf

CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\859\642\85964292\xml19\RFR0006.JPG
DESCRIPTION OF EVIDENCE FILE	Applicant submits herewith arguments and a Declaration in response to the Office Action dated June 3, 2015.
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use HEALTH NETWORK apart from the mark as shown.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Alan G. Towner/
SIGNATORY'S NAME	Alan G. Towner
SIGNATORY'S POSITION	Attorney of Record, PA Bar Member
SIGNATORY'S PHONE NUMBER	412-263-4340
DATE SIGNED	12/03/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Dec 03 11:01:41 EST 2015
TEAS STAMP	USPTO/RFR-XX.X.X.XX-20151 203110141445655-85964292- 540a3b1f0e16e6a45942998cc 7ab32b1ed6cae2a5877f18aa1 eb40c1b6acf3925-N/A-N/A-2 0151203105454214945

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85964292** ALLEGHENY HEALTH NETWORK (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/85964292/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant's arguments have been submitted as a pdf document as part of the Evidence File.

EVIDENCE

Evidence in the nature of Applicant submits herewith arguments and a Declaration in response to the Office Action dated June 3, 2015. has been attached.

Original PDF file:

[evi_101572-20151203105454214945_.HIIP-7_Arguments.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

Original PDF file:

[evi_101572-20151203105454214945_.HIIP-7_2nd_Declaration.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use HEALTH NETWORK apart from the mark as shown.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Alan G. Towner/ Date: 12/03/2015

Signatory's Name: Alan G. Towner

Signatory's Position: Attorney of Record, PA Bar Member

Signatory's Phone Number: 412-263-4340

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85964292

Internet Transmission Date: Thu Dec 03 11:01:41 EST 2015

TEAS Stamp: USPTO/RFR-XX.X.X.XX-20151203110141445655
-85964292-540a3b1f0e16e6a45942998cc7ab32
b1ed6cae2a5877f18aa1eb40c1b6acf3925-N/A-
N/A-20151203105454214945

Disclaimer

In Applicant's previous response dated March 28, 2014, a disclaimer of "HEALTH NETWORK" was submitted, which was entered into the record. However, the USPTO TESS and TSDR databases currently have no record of such a disclaimer. Accordingly, Applicant is repeating its disclaimer of "HEALTH NETWORK" in this Request for Reconsideration.

Acquired Distinctiveness

Registration of Applicant's "ALLEGHENY HEALTH NETWORK and Design" has been refused under 15 U.S.C. § 1052(e)(2) due to alleged geographic descriptiveness of the word "ALLEGHENY". In the response filed April 30, 2015, Applicant submitted Section 2(f) evidence of acquired distinctiveness in an attempt to overcome the geographic descriptiveness rejection.

However, in the Office Action dated June 3, 2015, the Examining Attorney has refused registration on the Principal Register based upon an alleged insufficiency of Applicant's previously submitted acquired distinctiveness evidence. Applicant disagrees that such evidence is insufficient, but in further support of Applicant's position that the subject "ALLEGHENY HEALTH NETWORK and Design" mark has acquired distinctiveness, submitted herewith is an additional Declaration establishing that Applicant has spent more than ten million dollars (\$10,000,000) in 2015, and a combined total of over twenty million dollars (\$20,000,000) for the years 2014 and 2015, advertising its services under the subject mark.

As demonstrated by the previous and currently submitted evidence, Applicant's mark, including the "ALLEGHENY HEALTH NETWORK" portion thereof, has acquired distinctiveness due to the type, expense, and amount of advertising of the mark in the United States, including Pennsylvania, Ohio, New York and West Virginia. Applicant's demonstrated extensive and widespread advertisements of the mark have resulted in the purchasing public viewing the mark as an indicator of origin. Through its advertising efforts, Applicant has successfully educated the public to associate the mark with a single source, and the mark has therefore acquired distinctiveness.

Applicant therefore respectfully requests withdrawal of the rejection under 15 U.S.C. § 1052(e)(2) and registration of the mark on the Principal Register.

Alternative Request for Registration on the Supplemental Register

In the alternative, if the Examining Attorney does not accept Applicant's Section 2(f) evidence as being sufficient to demonstrate acquired distinctiveness, Applicant hereby requests registration on the Supplemental Register pursuant to 15 U.S.C. §1091:

All marks capable of distinguishing Applicant's goods or services and not registrable on the Principal Register herein provided . . . which are in lawful use in commerce by the

owner thereof, on or in connection with any goods or services may be registered on the Supplemental Register upon the payment of the prescribed fee in compliance with the provisions of subsections (a) and (e) of Section 1 so far as they are applicable. 15 U.S.C. § 1091(a).

For purposes of registration on the Supplemental Register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the Applicant's goods or services. 15 U.S.C. § 1091(c).

The trademark statute makes clear that trademarks such as Applicant's present mark containing both a design component and wording are eligible for registration on the Supplemental Register. The Examining Attorney is invited to consider the following U.S. trademark registrations granted by the USPTO on the Supplemental Register that include both wording and a design component: 3,741,316; 4,848,240; 4,770,632; 3,690,784; 4,203,784; 4,326,076; 4,779,195; 4,650,633; 3,878,324; 4,650,623; 4,853,013; 4,848,139; 4,843,120; 4,852,947; and 4,848,271.

It would be contrary to the clear wording of the trademark statute 15 U.S.C. § 1091 set forth above, and the USPTO's practice of granting registrations on the Supplemental Register for marks having design components and wording, for the Examining Attorney in the current application to deny Applicant's request for registration on the Supplemental Register.

The Examining Attorney, in a telephone conversation with the undersigned, indicated that a refusal to allow the present mark to be registered on the Supplemental Register would be based upon TMEP § 815.01, and the *In re U.S. Catheter & Instrument Corp.*, 158 USPQ 53, 54 (TTAB 1968) and *Daggett & Ramsdell, Inc. v. I. Posner, Inc.*, 115 USPQ 96, 96, (Comm'r Pats. 1957) cases. However, the *In re U.S. Catheter & Instrument Corp.* and *Daggett & Ramsdell, Inc. v. I. Posner, Inc.* cases are not factually similar to the present situation because the marks at issue did not contain a design component along with an allegedly geographically descriptive word, as in the present application. Accordingly, the *In re U.S. Catheter & Instrument Corp.* and *Daggett & Ramsdell, Inc. v. I. Posner, Inc.* cases are distinguishable from the present situation, and cannot validly serve as a legal basis to prohibit registration of the present mark on the Supplemental Register.

Moreover, the plain wording of TMEP § 816.04 states that:

In an application under § 1 or § 44 of the Trademark Act, the applicant may amend to the Supplemental Register after a refusal to register on the Principal Register, including a final refusal. If the final refusal was under § 2(e)(1), § 2(e)(2), or § 2(e)(4) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1), 1052(e)(2), or 1052(e)(4), or on grounds pertaining to other non-inherently distinctive subject matter, amendment to the Supplemental Register is procedurally an acceptable response. *See* 37 C.F.R. § 2.75. When the applicant files an allegation of use that complies with the minimum requirements of 37 C.F.R. § 2.76(e) and an amendment to the Supplemental Register in

response to a refusal, the examining attorney must follow the procedures outlined in TMEP § 714.05(a)(i).

The applicant may argue the merits of the examining attorney's refusal of registration on the Principal Register and, in the alternative, request registration on the Supplemental Register. Similarly, the applicant may seek registration on the Principal Register based on acquired distinctiveness under § 2(f), 15 U.S.C. § 1052(f), and, in the alternative, on the Supplemental Register. *See* TMEP § 1212.02(c).

An amendment to the Supplemental Register after refusal presents a new issue requiring consideration by the examining attorney, unless the amendment is irrelevant to the outstanding refusal. If the examining attorney determines that the proposed mark is incapable of identifying and distinguishing the applicant's goods or services, the examining attorney must issue a nonfinal refusal of registration on the Supplemental Register, under §§ 23 and 45 of the Trademark Act, 15 U.S.C. §§ 1091 and 1127. *See* TMEP § 714.05(a)(i).

In the present case, if Applicant's submission of evidence of acquired distinctiveness is not accepted by the Examining Attorney, Applicant's mark would not be considered by the USPTO to be eligible for the Principal Register, i.e., the Examining Attorney would be maintaining the final rejection under 15 U.S.C. § 1052(e)(2) due to the alleged geographical descriptiveness of "ALLEGHENY". Applicant respectfully submits that the Examining Attorney cannot at the same time maintain a final rejection under 15 U.S.C. § 1052(e)(2) and also argue that the present mark is clearly eligible for the Principal Register pursuant to TMEP 815.01. Accordingly, in the event that the Examining Attorney considers Applicant's Section 2(f) evidence insufficient to overcome the 15 U.S.C. § 1052(e)(2) rejection, registration on the Supplemental Register is proper.

A Notice of Appeal is being submitted in this case. Applicant notes that, pursuant to TMEP § 1212.02(c):

An Applicant may argue the merits of an Examining Attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under Section 2(f) . . . the Applicant may seek registration on the Principal Register under Section 2(f) and, in the alternative, on the Supplemental Register. . . . Accordingly, the Applicant may submit an amendment to the Supplemental Register, and continue to argue entitlement to registration on the Principal Register in an appeal. If the Applicant files a Notice of Appeal in such a case, the Board will institute the appeal, suspend action on the appeal and remand the application to the Examining Attorney to determine registrability on the Supplemental Register. If the Examining Attorney determines that the Applicant is entitled to registration on the Supplemental Register, the Examining Attorney must send a letter notifying the Applicant of the acceptability of the amendment and telling the Applicant that the application is being referred to the Board for resumption of the appeal. If the Examining Attorney determines that the Applicant is not entitled to registration on the Supplemental Register, the Examining Attorney will issue a non-final action refusing registration on the Supplemental Register. If the Applicant fails to overcome the refusal,

the Examining Attorney will issue a final action, and refer the application to the Board to resume action on the appeal with respect to entitlement to registration on either the Principal or the Supplemental Register. TMEP § 1212.02(c)

In summary, Applicant submits that it has demonstrated that the subject mark has acquired distinctiveness, and that the mark is entitled to registration on the Principal Register. If the Examining Attorney continues to refuse registration on the Principal Register, registration on the Supplemental Register is requested by Applicant.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Law Office: 107
Applicant: Allegheny Health Network
Examining Attorney: Nicole Nguyen
Serial No.: 85/964,292
Mark: "ALLEGHENY HEALTH NETWORK and Design"
Int'l Classes: 41, 42, 44
Filed: June 19, 2013
Attorney Docket No.: HIIP-103292

DECLARATION IN LIEU OF OATH

Pursuant to 37 C.F.R. Section 2.20, the signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true, and hereby affirms the following:

The undersigned has been informed by Applicant that, in calendar year 2015, to date, Applicant spent more than ten million dollars (\$10,000,000) advertising the services listed in this application using the subject mark. Such expenditures are in addition to the greater than ten million dollar (\$10,000,000) advertising expenditures in 2014 stated in my prior Declaration dated April 30, 2015. The Applicant's advertising expenditures are thus over twenty million dollars (\$20,000,000) for the combined years 2014 and 2015.

The advertisements, including those identified in Exhibits A-D of my previous April 30, 2015 Declaration, have been made in Pennsylvania, Ohio, New York and West Virginia.

Signature: _____



Name: Alan G. Towner

Date: December 3, 2015

Position: Attorney of Record, PA Bar Member